

REMARKS

I. Status of the claims

Claims 1 and 4-14 are pending in this application. Claims 2 and 3 have been cancelled in a previous response. Claim 4 has been amended to become an independent claim by incorporating the limitations of claim 1. This amendment finds support, for example, in original claims 1-4. Claim 6 has been amended to correct a spelling error by replacing the word “cocrtystal” with “cocystal.” Claim 10 has been amended to correct a spelling error by replacing the word “power” with “powder.” No new matter has been introduced by these amendments.

II. Claim objections

The Office objected to claims 6 and 10 because of spelling errors. Office Action at 2. Applicants amended claim 6 to correct the spelling error by replacing the word “cocrtystal” with “cocystal.” Applicants also amended claim 10 by replacing the word “power” with “powder.” The objections are now moot and Applicants respectfully request that they be withdrawn.

III. Rejection under 35 U.S.C. § 112

The Office rejected claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite. According to the Office, “the limitation ‘A method as claimed in claim 3’” lacks antecedent basis. Office Action at 2. Applicants amended claim 4 to be in independent form, by incorporating the limitations of claim 1. This rejection is now moot and Applicants respectfully request that it be withdrawn.

IV. Double Patenting Rejection

The Office rejected claims 1 and 4-14 on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, 3, and 5 of U.S. Patent No. 7,372,941 ("the '941 patent.") Office Action at 3-4.

Without acquiescing to the Office's arguments, Applicants are filing concurrently with this response a Terminal Disclaimer over the '941 patent. Applicants note that "[t]he filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection." M.P.E.P. 804.02.II (citing *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991)). The M.P.E.P. further explains that "[t]he court [in *Quad Environmental Technologies*] indicated that the 'filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.'" *Id.* (internal citations omitted).

Accordingly, this rejection is now moot and Applicants respectfully request that it be withdrawn.

V. Rejection under 35 U.S.C. § 102

The Office rejected claims 1 and 4-14 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/012305 ("*Lemmo*"). Office Action at 5.

A. Claims 1, 4-10, and 14

With respect to claims 1, 4-10, and 14, the Office argues that *Lemmo* "discloses a method of screening an array of samples and determining if any share spectral

features.” *Id.* In the Office’s view, this method “is similar to comparing diffraction patterns, [as disclosed in *Lemmo*’s] paragraphs [0017] and [0021]-[0022], as well as the use of X-ray diffraction analysis in paragraph [0141].” *Id.* Applicants respectfully traverse this rejection.

Independent claims 1 and 4 recite a method comprising “providing a PDF trace” of a first and second samples of a substance, and then “comparing the PDF traces.” Dependent claims 5-10 and 14 also share these limitations by virtue of their dependency from claim 1. Applicants respectfully remind the Office that in an anticipation rejection, the Office needs to show that a single reference contains all of the elements of the claim. M.P.E.P. § 2131. In this case, however, *Lemmo* is completely silent regarding the use of a PDF trace for any purpose. *Lemmo* discloses that IR and Raman could be “useful in detecting changes in structure and/or order.” (paragraph [0008] but there is no mention of PDF traces. Paragraphs [0017] and [0021]-[0022], cited by the Office, simply disclose the use of Raman spectra of samples in methods for determining whether compounds share spectral features. Paragraph [0141], also cited by the Office, discloses “examples of spectroscopic techniques that can be used to bin or analyze samples.” The use of a PDF trace, however, is nowhere mentioned and Applicants point out that a PDF trace is NOT an XRPD diffraction pattern. See, e.g., paragraphs 23-28 of the instant application. Because *Lemmo* fails to disclose the use of a PDF trace and the comparison of PDF traces, *Lemmo* does not anticipate claims 1, 4-10, and 14. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Claim 11

With respect to claim 11, the Office argues that *Lemmo* “discloses in paragraph [0018] the screening of an array of samples for the presence of a particular form of a compound-of-interest” and that “paragraph [0203] presents an example of the analysis done using a known sample.” Office Action at 5-6. Applicants respectfully traverse this rejection.

Claim 11 is directed to a method of screening for new solid forms comprising “providing a PDF trace of each of a plurality of test samples of a substance . . . providing one or more PDF traces of known solid forms of the substance,” and “comparing the PDF traces of one or more of the test samples to one or more of the PDF traces of known solids.” As mentioned above, *Lemmo* does not disclose the use of PDF traces at all, much less the comparison of one or more PDF traces of test samples to one or more of the PDF traces of known solids. For at least this reason, *Lemmo* fails to anticipate claim 11. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C. Claim 12

With respect to claim 12, the Office argues that *Lemmo* “discloses a method of analyzing and calculating similarities of a plurality of samples via clustering.” Office Action at 6. Applicants respectfully traverse this rejection.

Claim 12 is directed to a method comprising “providing a PDF trace of each of a plurality of test samples of a substance, and grouping the plurality of PDF traces by similarity into two or more groups through hierarchical cluster analysis.” As mentioned above, *Lemmo* does not disclose the use of PDF traces at all, and, therefore, cannot

disclose a method comprising “grouping the plurality of PDF traces” as recited in claim 12.

For at least this reason, *Lemmo* fails to anticipate claim 12. Accordingly, Applicants respectfully request that this rejection be withdrawn.

D. Claim 13

With respect to claim 13, the Office argues that *Lemmo* at “[p]aragraph [0020] . . . discloses a system for analyzing samples using a method as disclosed in [*Lemmo*’s] paragraphs [0017] and [0021-[0022] that encompasses analyzing a plurality of samples using spectral data to identify similarities. Office Action at 6. Applicants respectfully traverse this rejection.

Claim 13 is directed to a system comprising “means for comparing the PDF traces] of a first sample of a substance with that of a second sample to determine whether the substance of the first and second samples “have the same or different solid forms.” As mentioned above, *Lemmo* does not disclose the use of PDF traces at all. Consequently, *Lemmo* cannot disclose a system comprising means for comparing PDF traces.

For at least this reason, *Lemmo* fails to anticipate claim 13. Accordingly, Applicants respectfully request that this rejection be withdrawn.


VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 5, 2009